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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/702,361	11/06/2003	Melissa Lee Merlau	A01462	8529

21898 7590 06/21/2005

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EXAMINER	
VANIK, DAVID L	

ART UNIT	PAPER NUMBER
1615	

DATE MAILED: 06/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/702,361	MERLAU ET AL.	
	Examiner	Art Unit	
	David L. Vanik	1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-9 is/are pending in the application.

4a) Of the above claim(s) 8 and 9 is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-7 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) 1-9 are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Receipt is acknowledged of the applicant's Information Disclosure Statements filed on 9/30/2004 and 11/23/2004.

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

   I. Claims 1-7, drawn to a polymer-based composition, classified in class 424, subclass 401.

   II. Claims 8-9, drawn to a method for styling hair, classified in class 424, subclass 70.1.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the product can be used in a materially different manner. The product as claimed can used as a cosmetic composition, such as a lipstick or mascara.

3. Searching the inventions of Groups I – II together would impose a search burden on the examiner. In the instant case, the search of a product and method of using said product would impose a search burden on the examiner.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

5. Because these inventions are distinct for the reasons given above and the search required for each subset of Groups I – II are not required for one another, restriction for examination purposes as indicated is proper.

6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

7. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

8. During a telephone conversation with Tom Rogerson on 6/10/2005 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-7.

Affirmation of this election must be made by applicant in replying to this Office action. Claims 8-9 are withdrawn from further consideration by the examiner as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 6,136,884 ('884).

'884 disclose a latex composition for hair care (abstract). Said composition comprises a hybrid graft copolymer further comprising at least two distinct polymers (column 2, lines 38-43 and Claims 1-19). Specifically, the two distinct polymers used in the invention advanced by '884 can be a (1) sulfopolyester copolymer and a (2) acid-functional polymer (Claims 1 and 17). Like the instant application, the polymer system advanced by '884 comprises homopolymer and copolymers derived from polyesters (column 4, lines 7-8), ethylenically unsaturated monomers (column 4, lines 44-65), and acid functionalized monomers, such as methacrylic acid (column 4, lines 16-43). The glass transition temperature (Tg) of the two polymers can also be different: (1) the Tg of the sulfopolyester group can be between about 15 to about 60° C, and (2) the Tg of the

acid-functional polymer can be between about 40 to about 80° C (Claims 8 and 19, column 3, lines 43-44, and column 7, lines 12-20). Thus, like the instant application, the difference in Tg between the first polymer, an acid-functional polymer, and the second polymer, a sulfopolyester copolymer, can be 20° C or more.

The polymer system advanced by '884 can be dissolved together in a cosmetically acceptable solvent (column 8, lines 33-64). The hair care formulation can also be fashioned into a film (column 8, lines 14-32). It is the examiner's position that, inherently, when fashioned into a film, the composition advanced by '884 has a tensile storage modulus at 20° C of from about $1x10^{10}$ Pascal to $1x10^{8}$ Pascal and a storage modulus at 70° C of from about $1x10^{9}$ Pascal to $1x10^{6}$ Pascal. Since the essential elements of the '884 composition are identical to the instant compositions (that is, a composition comprising two polymers with different Tg values and a cosmetically acceptable solvent wherein the first polymer has a Tg between about 30 to about 250° C and the second polymer has a Tg between about 20 to about 35° C), the composition would inherently have the same physiochemical properties as the compositions set forth in the instant application. As such, it is the examiner's position that the composition advanced by '884 anticipates the compositions enumerated in the instant claim set.

The claims are therefore anticipated by US Patent 6,136,884 ('884).

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US Patent 6,638,992 is cited as a patent of interest in its disclosure of hair care compositions comprising polymers with different glass transition

temperatures. US Patents 6,165,457 and 6,153,206 are also cited as patents of interest in their disclosure of cosmetic compositions comprising polymers with different glass transition temperatures.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David L. Vanik whose telephone number is (571) 272-3104. The examiner can normally be reached on Monday-Friday 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carlos Azpuru, can be reached at (571) 272-0588. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David Vanik, Ph.D.
Art Unit 1615

6/15/05

CARLOS A. AZPURU
PRIMARY EXAMINER
GROUP 1500